

## Department of Energy

## § 781.62

taken effective steps, or within a reasonable time thereafter is expected to take such steps, necessary to accomplish substantial utilization of the invention.

### § 781.53 Additional licenses.

Subject to any outstanding licenses, nothing in this part shall preclude the Department from granting additional nonexclusive, or exclusive, or partially exclusive licenses for inventions covered by this part when the Department determines that to do so would provide for an equitable exchange of patent rights. The following circumstances are examples in which such licenses may be granted:

- (a) In consideration of the settlement of interferences;
- (b) In consideration of a release of any claims;
- (c) In exchange for or as a part of the consideration for a license under adversely held patents; or
- (d) In consideration for the settlement or resolution of any proceeding under the Department of Energy Organization Act or other law.

### PROCEDURES

### § 781.61 Publication of DOE inventions available for license.

(a) The Department will publish periodically in the FEDERAL REGISTER a list of the DOE inventions available for licensing under this part. In addition, a list of those DOE inventions that are protected in the United States will be published in the U.S. Patent and Trademark Office Official Gazette and in the National Technical Information Service (NTIS) publication "Government Inventions for Licensing."

(b) Interested persons may obtain copies of such lists by contacting the General Counsel, Attention: Assistant General Counsel for Patents, U.S. Department of Energy, Washington, DC 20545. Copies of U.S. patents may be obtained from the U.S. Patent and Trademark Office, Washington, DC 20231. Copies of U.S. patent applications, specifications, or microfiche reproductions thereof may be secured at reasonable cost from the National Technical Information Service (NTIS), Springfield, Virginia 22151.

### § 781.62 Contents of a license application.

An application for a license under a DOE invention must be accompanied by a processing fee of \$25 for each patent or patent application under which a license is desired, which shall be credited towards royalty if royalties are charged, and must include the following information:

- (a) Identification of the invention for which the license is desired, including the title of the invention and the patent application serial number or the patent number of the invention;
- (b) Name and address of the person applying for a license and whether the applicant is a U.S. citizen or U.S. organization;
- (c) Name and address of a representative of the applicant to whom correspondence should be sent and any notices served;
- (d) Nature and type of the applicant's business;
- (e) Applicant's status, if any, as a small business firm, minority business firm, or business firm located in a labor surplus area, low-income area, or economically depressed area.
- (f) Identification of the source of the applicant's information concerning the availability of a license on the invention;
- (g) A statement of the field or fields of use in which the applicant intends to practice the invention;
- (h) A statement of the geographic area or areas in which the applicant proposes to practice the invention, including a statement of any foreign countries in which the applicant proposes to practice the invention;
- (i) A description of the applicant's technical and financial capability and plan for bringing the invention to a point of practical or commercial application, and the applicant's offer to implement that plan, if the license is granted.
- (j) The amount of royalty fees or other consideration, if any, that the applicant would be willing to pay the Government for the license;
- (k) Applicant's knowledge of the extent to which the invention is being practiced by private industry and the Government; and